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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,253	01/31/2000	Osamu Yamada	44239-066	3198
20277	7590	03/29/2004		
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
			EXAMINER TRAN, DOUGLAS Q	
			ART UNIT 2624	PAPER NUMBER
DATE MAILED: 03/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/494,253

Applicant(s)

YAMADA ET AL.

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner has reviewed the allowed claims 9-15, and 17. However, the allowed claims made in the prior Office action are withdrawn. The claims 9-15, and 17 have been considered but are moot in view of the new ground(s) of rejection. **This action is made non-final.**

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ikenoue et al. (US Patent No. 5,671,277).

As to claim 9, Ikenoue teaches an image formation apparatus (fig. 13) comprising:
an input unit entering image data (1 or 2 or 3 or 4 in fig. 13),
a printer unit (i.e., output unit 6 in fig. 13) printing out image data (i.e., hard copy in fig. 13);
a memory (i.e., image memory 16 in fig. 13) storing trigger information to initiate execution of a control operation and the control operation in corresponding (col. 9, lines 57-64),
a detector (i.e., 11 or 12 or 13 in fig. 13) detecting additional information including the trigger information from the image data (col. 9, lines 40-43: the image data including additional

Art Unit: 2624

data of which the trigger information is indicated in fig. 3; col. 7, lines 5-6; col. 5, line 66 to col. 6, line 3 and table 1 in col. 6 indicates the trigger information embedded in the image data); and

a controller (i.e., a processor from the image processor 100 in fig. 1) responsive to detection of the trigger information to execute the control operation corresponding to the trigger information stored in the memory (col. 9, lines 62-64; the image processor inherently comprises a component corresponding to the controller for detecting the trigger information from the additional data at the memory 16 to execute the control operation),

wherein the control operation includes a transmission operation (5 in fig. 13) transmitting print information related to printing of the image data to a destination (i.e., the management unit 200 in fig. 1) (col. 9, lines 61-62).

As to claim 10, Ikenoue discloses every feature discussed in claim 9, and further teaches of an operation unit (i.e., 4 in fig. 13) setting the trigger information and control operation in corresponding (col. 9, line 67 to col. 10, lines 4, 8-11).

As to claim 11, Ikenoue discloses every feature discussed in claim 9, and further teaches the print information includes information indicating an event of printing the image data (col. 5, line 66 to col. 6, line 25 indicates that the additional data including the print information for printing the image data and the additional data is transmitted to the output device “col. 9, lines 60-62”).

As to claim 12, Ikenoue discloses every feature discussed in claim 9, and further teaches the print information includes a print condition in printing the image data (col. 5, line 66 to col. 6, line 25 indicates that the additional data including the print condition for printing the image data and the additional data is transmitted to the output device “col. 9, lines 60-62”).

Art Unit: 2624

As to claim 13, Ikenoue discloses every feature discussed in claim 9, and further teaches the control operation includes a print operation print out the image data according to a predetermined print condition (col. 10, lines 4-7).

As to claim 14, Ikenoue discloses every feature discussed in claim 9, and further teaches the control operation includes an image processing operation processing the image data according to a predetermined image processing condition (col. 10, lines 4-7).

As to claim 17, Ikenoue teaches an image recording apparatus (fig. 13) comprising:
an input unit entering image data (1 or 2 or 3 or 4 in fig. 13),
a printer unit (i.e., output unit 6 in fig. 13) printing out image data (i.e., hard copy in fig. 13);

a detector (i.e., 11 or 12 or 13 in fig. 13) detecting the additional information from the image data, the additional information including the trigger information to initiate execution of a predetermined control operation (col. 9, lines 40-43: the image data including additional data of which the trigger information is indicated in fig. 3; col. 7, lines 5-6; col. 5, line 66 to col. 6, line 3 and table 1 in col. 6 indicates the trigger information embedded in the image data to initiate execution of the predetermined control operation "col. 10, lines 4-7"); and

a controller (i.e., a processor from the image processor 100 in fig. 1) executing the predetermined control operation in response to detection of the trigger information (col. 9, lines 62-64; the image processor inherently comprises a component corresponding to the controller for detecting the trigger information from the additional data at the memory 16 to execute the control operation),

Art Unit: 2624

wherein the predetermined control operation includes a transmission operation (5 in fig. 13) transmitting information related to recording of the image data to a destination (i.e., the management unit 200 in fig. 1) (col. 9, lines 61-62).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ikenoue as applied to claim 9, and in combination with Chapman et al. (US Patent No. 6,522,421 B2).

As to claim 15, Ikenoue discloses every feature discussed in claim 9.

However, Ikenoue does not teach the transmission operation includes an operation of transmitting the print information to a destination specified by an electronic mail address through electronic mail.

Chapman teaches a transmission operation includes an operation of transmitting (i.e., box 49 in fig. 2) the print information (i.e., a message) to a destination specified by an electronic mail address through electronic mail (col. 3, lines 40-47 describes that the information is mailed to the extracted email addresses. The message "or printing information" related to printing of the image data such as finishing options, pages printed, job completion "col. 3, lines 45-47" ; and it is noted that, with respect to box 49 in fig. 2, the printer inherently comprises a component

Art Unit: 2624

corresponding to a transmission controller for sending the printing information to the extracted email address that is the detected destination).

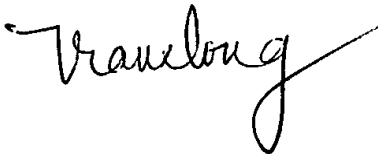
It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the transmission operation of Ikenoue for transmitting the print information to the output device by email address as taught by Chapman. The suggestion for modifying the transmission operation of Ikenoue can be reasoned by one of ordinary skill in the art as set forth above by Chapman because the modified printing system of Ikenoue and Chapman would increase the flexibility and efficiency by using any of new technologies such as an email for transmitting the data to the any of the output devices.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Mar. 23, 2004

A handwritten signature in black ink, appearing to read "Tran Douglas", with a long, sweeping horizontal stroke extending to the right.